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PATENT APPLICATION

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UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):   Raja DAOUD et al.

Confirmation No.: 6164

Application No.: 09/751,009

Examiner: Sall, E. H. M.

Filing Date: 12/29/00

Group Art Unit: 2157

Title: **APPARATUS AND METHOD FOR IDENTIFYING A REQUESTED LEVEL OF SERVICE FOR A TRANSACTION**

Mail Stop Appeal Brief - Patents
Commissioner For Patents
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Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on ____12/08/06____.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

   (Note: Extensions of time are not allowed under 37 CFR 1.136(a))

   (Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Respectfully submitted,

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Rev 10/05 (ReplyBrf)

Applicant:	Daoud, R.	Patent Application	
Serial No.:	09/751,009	Art Unit:	2157
Filed:	December 29, 2000	Examiner:	Sall, El Hadji Malick

For: Apparatus and Method for Identifying a Requested Level of Service for a Transaction.

Reply Brief

In response to the Examiner's Answer mailed on December 8, 2006, Appellant respectfully submits the following remarks.

<center>REMARKS</center>

Appellant is submitting the following remarks in response to the Examiner's Answer. In these remarks, Appellant is addressing certain arguments presented in the Examiner's Answer. While only certain arguments are addressed in this Reply Brief, this should not be construed that Appellant agrees with the other arguments presented in the Examiner's Answer.

<center>Item A of the Examiner's Response to Argument</center>

In item A of the Examiner's response to the Appellant's argument on pages 9 and 11-12 (please see page 11 of the Examiner's Answer), the Examiner discusses that Bearden discloses enabling service providers and clients to establish service-level agreements. However, As shown in Bearden's FIG. 4, and specifically in decision boxes 411 and 412, and in steps 417 and 418, Bearden's QoS goals cause the network resources assigned to a particular client to be increased or decreased based on whether a QoS goal was met (or not) for past transactions. Thus, the client is not prompted to "select a requested level of service" for any particular transaction, but is only prompted to specify a QoS goal for all transactions.

In view of the above remarks, Appellant continues to assert that Bearden does not disclose the present claimed features, for reasons previously presented in the Appeal Brief.

<center>Item B of the Examiner's Response to Argument</center>

In item B of the Examiner's response to the Appellant's argument on pages 10 and 12 (please see page 11 of the Examiner's Answer), the Examiner states that limitations such as "select a requested level of service" for any particular transaction is not in the Claims.

However, Appellant respectfully submits that the Appeal Brief and Claim 3 clearly state the feature "program code for selecting a <u>backup</u> level of service" (emphasis added). Thus, Appellant respectfully points out that Claim 3 does in fact include the stated Claim language discussed in the Appeal Brief.

In view of the above remarks, Appellant continues to assert that Bearden does not disclose the present claimed features, for reasons previously presented in the Appeal Brief.

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Item C of the Examiner's Response to Argument
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In item C of the Examiner's response to the Appellant's argument on pages 10 (please see pages 12 and 13 of the Examiner's Answer), the Examiner states that the Examiner construed this limitation as "backup level of service" or backup (i.e., to make a copy of important information onto a different storage medium for safety...)

Appellant respectfully submits the "backup level of service" words of the claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983). Moreover, the backup level of service terminology is clearly defined in the Specification.

Specifically, the Specification clearly states on page 8 lines 18-27 "For example, the service tag may indicate a preferred level of service and a backup level of service. In such an embodiment, <u>where the preferred level of service is unavailable</u>, the transaction is preferably handled or processed <u>according to the backup level of service</u>. In addition, in this embodiment the transaction may be

"bounced" (i.e., returned to the originating computer) where <u>neither the preferred level of service nor the backup level of service</u> can be provided. Or a warning or a message may be returned to the originator where either the backup level of service is provided or where neither is provided" (emphasis added).

Therefore, as clearly stated in the specification, the backup level of service is utilized when the preferred level of service is unavailable. Moreover, the transaction may be "bounced" (i.e., returned to the originating computer) where <u>neither the preferred level of service nor the backup level of service</u> can be provided. Thus, Appellant respectfully submits that the term backup level of service is not analogous to a backup- e.g., make a copy.

In view of the above remarks, Appellant continues to assert that Bearden does not disclose the present claimed features, for reasons previously presented in the Appeal Brief.

<u>Item D of the Examiner's Response to Argument</u>
In item D of the Examiner's response to the Appellant's argument on pages 13 and 14 (please see page 13 of the Examiner's Answer), the Examiner states that the codepoint is used (for example using a mapping table) to select the PHB to which the traffic is subjected as it passes through a node (i.e. inherently the same as "selecting said requested level of service for transaction").

Appellants recognize that inherent disclosures of a reference may be relied upon in a rejection under 35 U.S.C. §102(e). However, Appellants respectfully submit that the use of inherency in the final rejection fails to satisfy the requirements set forth in the Manual of Patent Examining Procedure (MPEP §

2112). "The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" (emphasis in original). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is <u>necessarily</u> present in thing described in the reference, <u>and</u> that it would be so recognized by persons of ordinary skill. Inherency, however, may <u>not</u> be established by probabilities or possibilities. The mere fact that a certain thing <u>may</u> result from a given set of circumstances is <u>not</u> sufficient.'" (emphases added; In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Davies mentions routes packets, as opposed to directing transactions. Appellants respectfully submit that there is no basis for concluding that Davies is referring to directing transactions. The data described by Davies appears to packet-routing. Therefore, Appellants respectfully submit that there is nothing in Davies to suggest that the claim limitation is anticipated.

In view of the above remarks, Appellant continues to assert that Bearden does not disclose the present claimed features, for reasons previously presented in the Appeal Brief.

Conclusion

Appellants believe that pending Claims 1, 3, 4, 5 and 9 are patentable over Bearden. Moreover, Appellants believe that pending Claims 14, 15, 17 and 19 are patentable over Davies in view of Official Notice. As such, Appellants submit that Claims 1-28 are patentable over the prior art.

Appellants respectfully request that the rejection of Claims 1-5, 9, 14, 15 and 17-18 be reversed. The Appellants wish to encourage the Examiner or a member of the Board of Patent Appeals to telephone the Appellants' undersigned representative if it is felt that a telephone conference could expedite prosecution.

Respectfully submitted,
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Dated: 2/7 , 2007

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